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In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 747

HAROLD L. MACK,
Petitioner,

vs.

EDWARD J. BRENNER,
Commissioner of Patents,
Respondent.

Brief for Petitioner in Reply

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

The Commissioner of Patents' answering brief is an over-simplification of the subject matter presented to this Court. However, there are two important points of agreement. *First,* it agrees that jurisdiction for a Writ of Certiorari is properly urged in this case.[1] *Second,* the only prosecution question involved is whether

1. See footnote 3, Commissioner's Brief, page 4.

or not Petitioner's claims were *anticipated* by the Davidson Patent No. 2,164,702.[2]

The argument subverts the questions presented by Petitioner to details of the patent prosecution which are not answers to these questions.

QUESTION NUMBER 1 IS MERITORIOUS

It is said that there is no merit to Petitioner's question Number 1 because the entire Davidson patent specification, including the claims, must be considered in determining what is disclosed. This, like many legal truisms, is meaningless when taken out of context. It further neglects to point out that the claims can never be interpreted to expand the specification nor given a construction broader than that of the specification so as to cover something which might have been claimed but was not.[3]

QUESTION NUMBER 2 WAS PRESENTED TO BUT NOT DECIDED BY THE COURT OF CUSTOMS AND PATENT APPEALS

With respect to Petitioner's question Number 2, the Commissioner's Brief admits that the claims were rejected on the ground of anticipation, and nothing else. Accordingly, only Section 102 of 35 U.S.C. is properly before this Court.

Long before the Patent Act of 1952, and epitomized at the present time, anticipation is defined:

> "Anticipation means the disclosure in the prior art of a thing substantially *identical* with the claimed invention. An

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2. Commissioner's Brief, page 2.

3. *4 Deller's Walker on Patents,* Second Edition, page 129, (1965). *United Carbon Co. v. Binney & Smith Co.,* 317 U.S. 228; 87 L.Ed. 232 (1942); *Universal v. Sonn,* 154 F. 665 (2nd Cir. 1907); *Borg-Warner v. Mall,* 217 F.2d 850 (7th Cir. 1954). Since the word "filter" is not used in the specification of the Davidson patent, nor its function as a filter described therein, the claims containing the word "filter" cannot be construed as if the function and the word were described in the specification.

invention is anticipated when the prior art disclosure is *identical* in substance with it."[4] (Emphasis supplied)

Identity, accordingly, is essential to establish anticipation.

Three process [method] claims are involved, i.e., 1, 2 and 5 (PR. 53). This Court has long held that a process is only anticipated by the showing of substantially the same process or by a similar process. *Brown v. Piper*, 91 U.S. 37; 23 L.Ed. 200 (1875); *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403; 46 L.Ed. 968 (1902). There has been no determination that the Davidson patent discloses an identical process.

Likewise, the two product claims (PR. 53) are anticipated only by a prior device of like construction and capable of performing the same function. Whether the Davidson plug or filler is or is not a "filter" is merely a preliminary facet and is not determinative of the ultimate issue of anticipation. No matter what the Davidson mouthpiece is called, filler or "filter", it is not treated in the manner called for by Petitioner's claims.

Petitioner's claims are not directed to filters in general, or all filters, but only those which effectively remove tar and nicotine as well as other products of combustion. Davidson's filler or "filter" does not do this. It functions to permit: (PR. 49, col. 1, line 31)

> "the cigarette to draw naturally, and when inserted between the lips of the user be substantially indistinguishable to the senses from which the ordinary cigarette of the smoker has become accustomed."

As to the process claims, the treatment described by Davidson was only in connection with mouthpieces which had been previously treated to be fire resistant and suitably sized (PR. 51, col. 2, lines 27-35). There is no disclosure as to why such fillers only

4. *1 Deller's Walker on Patents*, Second Edition, p. 237 (1964).

were treated, but it is reasonable to conclude that since sizing is a glue, and fire resistant materials are normally salts, it was done to mask these undesirable flavors. There is no disclosure whatever in Davidson that the treatment was to restore the tobacco flavor to the smoke which had been removed by the filtering. This can hardly be said to be identical either as to the method of treatment or resulting product.[5]

From this it appears that Petitioner's question Number 2 is well taken and that in order to establish anticipation under Section 102, 35 U.S.C. there must be an identical prior disclosure and not merely "inherent features".

QUESTION NUMBER 3 IS ESTABLISHED

The Commissioner's Brief makes no answer to question Number 3 and indeed, there is and can be no answer. A reading of the Court of Customs and Patent Appeals' Opinion shows that it decided nothing of consequence with respect to the issues before it, and it exhibits a complete breakdown of the judicial function. It decided merely (and incorrectly) that the Davidson patent referred to a filter and that the axial passages did not prevent it from functioning as a filter. Even if this were true it does not mean that the Davidson filler was treated in the same manner and for the same purposes so as to be identical and an anticipation under 35 U.S.C. Section 102, which the Commissioner's Brief now states is the only question. This question was not even referred to, much less decided by the Court of Customs and Patent Appeals.

It is needless to point out that the only way for the private litigant to obtain relief from the breakdown of the judicial function

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5. This coupled with the admission by the Commissioner in his Brief before the Court of Customs and Patent Appeals, page 3:

> "The claims specify features of such a method, and the filter produced, *which are not described by Davidson,*" (Emphasis supplied)

makes it clear that neither the process nor the product described by Davidson is identical or substantially the same as Petitioner's.

of the Court of Customs and Patent Appeals, is through Certiorari. It is believed that the criteria for this Court's review are satisfied and that the Writ should be granted.

Respectfully submitted,

HENRY GIFFORD HARDY
Attorney for Petitioner

San Francisco, California
January 6, 1966.